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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,338	01/26/2004	Christopher Clemmett Macleod Beck	P8600	9881

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EXAMINER

CHEEMA, UMAR

ART UNIT	PAPER NUMBER
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2144

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/765,338	Applicant(s) MACLEOD BECK ET AL.	
	Examiner UMAR CHEEMA	Art Unit 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 40-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This action is response to the Amendment filed on 28 January 2008. Claims 40-69 are pending in this application. Claims 1-39 have been cancelled and claims 40-69 are new added claims.

Response to Arguments

Applicant's arguments with respect to claims 40-69 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Software, *per se*:

The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." Both types of "descriptive material" are nonstatutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that

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the claims for an algorithm in *Benson* were unpatentable as abstract ideas because “[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.”).

Claims 40-53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The invention of these claims can be done by software application according to the specification paragraph 0026. Accordingly, software application is non-statutory subject matter, therefore the claims as whole are found to be directed to a non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 40-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shtivelman (US Patent # 6,535,492) in view of Matsui et al (Matsui) (US Patent # 6,401,122).

Regarding claims, 1-39 (Cancelled).

Regarding claim 40, Shtivelman discloses substantially the invention as claimed a communication management system, comprising:

a computer appliance (see abstract, figure 1 details; system is using computer appliances); software stored on and executable from a data repository accessible by the computer appliance (see abstract; col. 2, lines 27-43; data repository storing parameters and a management software executes on a server associated with the communication center system), the software providing:

one or more activity-specific zones (see col. 1, lines 45-56; rules and regulations regarding sessions); a user identity associated with each of the zones; and a set of contact identities associated with each of the zones;

wherein policy determined in part by associated user and contact identities is enforced in managing communication from and to each zone (see col. 1, lines 28-35, col. 2, lines 44-57).

Shtivelman substantially discloses the invention as claimed for the given reason above however does not explicitly disclose wherein said a user identity associated with each of the zones. However in the same field of invention Matsui discloses wherein said a user identity associated with each of the zones (see figure 1, col. 8, lines 41-59; area identifiers each for mutually discriminating a plurality of communication areas).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Shtivelman and Matsui for a communication management system. Motivation for doing so would have been this system is advantageous for a communication management apparatus for managing a joining of symbols in a virtual world in a message communication system in which a plurality of user terminals are interconnected, the plurality of user terminals sharing the virtual world comprising a plurality of virtual spaces, and the symbols each defined for the associated one of the user terminals which will join the virtual world, and messages are exchanged among a plurality of user terminals corresponding to a plurality of symbols which have entered the same virtual space (see Matsui: col. 1, lines 7-14).

Regarding claim 41, the combination of Shtivelman and Matsui disclose wherein Matsui further discloses the system of claim 40 wherein the user identity refers to a single user, but may vary from zone to zone as an alias (see figure 1, col. 8, lines 41-59).

Regarding claim 42, Shtivelman discloses the system of claim 40 wherein the communication involves transmission over the Internet network (see figure 1 (13); Internet).

Regarding claim 43, the combination of Shtivelman and Matsui disclose wherein Matsui further discloses the system of claim 40 wherein the contact identifies include one or

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more identities of persons accessible on a communication network (see col. 16, lines 9-25).

Regarding claim 44, the combination of Shtivelman and Matsui disclose wherein Matsui further discloses the system of claim 43 wherein individual ones of the contact identifies may be aliases referring to a single contact (see figure 1, col. 8, lines 41-59).

Regarding claim 45, Shtivelman discloses the system of claim 40 wherein individual ones of the zones are defined by various social environments engaged in by the user (see col. 1, lines 57-67, col. 2, lines 1-2).

Regarding claim 46, Shtivelman discloses the system of claim 42 wherein communication is supported in multiple modes and protocols, including but not limited to voice and text modes (see col. 1, lines 17-27).

Regarding claim 47, the combination of Shtivelman and Matsui disclose wherein Matsui further discloses the system of claim 46 wherein contact identity sets vary by communication mode as well as by zone (see figure 1, col. 8, lines 41-59).

Regarding claim 48, Shtivelman discloses the system of claim 46 wherein the multiple modes include email, instant messaging, RSS, and voice mode (see col. 1, lines 17-27).

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Regarding claim 49, the combination of Shtivelman and Matsui disclose the system of claim 40 wherein pairing of user with contact identity is used in determining and enforcing communication policy (see Shtivelman: col. 1, lines 28-35, col. 2, lines 44-57; Matsui: col. 8, lines 41-59).

Regarding claim 50, Shtivelman discloses the system of claim 40 further comprising generating alerts from attempted policy violation (see col. 7, lines 37-45).

Regarding claim 51, Shtivelman discloses the system of claim 40 wherein a user identity may be in a form of a URL, an email address, a telephone number, a machine address, an IP address, or an Enum address (see col. 1, lines 17-27, col. 5, lines 32-42).

Regarding claim 52, the combination of Shtivelman and Matsui disclose the system of claim 40 wherein policy includes protocol for automatic handling of incoming communication events, the handling determined by one or both of contact identity of sender and mode of communication (see Shtivelman: figure 3, col. 1, lines 28-35, col. 2, lines 44-57; Matsui: col. 8, lines 41-59).

Regarding claim 53, the combination of Shtivelman and Matsui disclose wherein Matsui further discloses the system of claim 40 further comprising an editing facility for a user

to create and populate zones, identities and policy (see col. 8, lines 41-59,).

Regarding claim 54, Shtivelman discloses substantially the invention as claimed a method for managing communication, comprising steps of:

(a) at a communication interface provided by software executing from a data repository of a computer appliance, prior to sending an outgoing message from, or routing an incoming message to one of a set of activity-specific zones, considering user and contact identifies associated with the zone (see figure 1; col. 1, ; lines 17-27, incoming and outgoing communications; col. 2, lines 27-43; data repository storing parameters and a management software executes on a server associated with the communication center system and col. 1, lines 45-56; rules and regulations regarding sessions); and
(b) enforcing policy in the sending or routing determined at least in part by user identity and contact identities associated with the zone (see col. 1, lines 28-35, col. 2, lines 44-57).

Shtivelman substantially discloses the invention as claimed for the given reason above however does not explicitly disclose wherein said contact identity associated with the zone. However in the same field of invention Matsui discloses wherein said contact identity associated with the zone (see figure 1, col. 8, lines 41-59; area identifiers each for mutually discriminating a plurality of communication areas).

It would have been obvious to one of the ordinary skill in the art of networking at the time of this invention to combine the teaching of Shtivelman and Matsui for a

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communication management system. Motivation for doing so would have been this system is advantageous for a communication management apparatus for managing a joining of symbols in a virtual world in a message communication system in which a plurality of user terminals are interconnected, the plurality of user terminals sharing the virtual world comprising a plurality of virtual spaces, and the symbols each defined for the associated one of the user terminals which will join the virtual world, and messages are exchanged among a plurality of user terminals corresponding to a plurality of symbols which have entered the same virtual space (see Matsui: col. 1, lines 7-14).

Regarding claim 55, Shtivelman discloses the method of claim 54 further comprising a step for content analysis of message and/or attachment for identification and verification of a contact (see col. 7, lines 8-20).

Regarding claim 56, the limitations of this claim has already been addressed (see claim 41 above).

Regarding claim 57, the limitations of this claim has already been addressed (see claim 42 above).

Regarding claim 58, the combination of Shtivelman and Matsui disclose the method of claim 54 wherein the contact identities include one or more user identities of other users

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also using an instance of the software on a different computer appliance (see Shtivelman: figure 1, col. 27-44 and Matsui: col. 8, lines 41-59).

Regarding claim 59, the limitations of this claim has already been addressed (see claim 44 above).

Regarding claim 60, the limitations of this claim has already been addressed (see claim 45 above).

Regarding claim 61, the limitations of this claim has already been addressed (see claim 46 above).

Regarding claim 62, the limitations of this claim has already been addressed (see claim 47 above).

Regarding claim 63, the limitations of this claim has already been addressed (see claim 48 above).

Regarding claim 64, the limitations of this claim has already been addressed (see claim 49 above).

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Regarding claim 65, the limitations of this claim has already been addressed (see claim 50 above).

Regarding claim 66, the limitations of this claim has already been addressed (see claim 51 above).

Regarding claim 67, the limitations of this claim has already been addressed (see claim 52 above).

Regarding claim 68, the limitations of this claim has already been addressed (see claim 53 above).

Regarding claim 69, combination of Shtivelman and Matsui disclose wherein Matsui further discloses the method of claim 68 wherein some of the user identities may be temporary ad hoc identifies (see figure 1, col. 8, lines 41-59).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to UMAR CHEEMA whose telephone number is (571)270-3037. The examiner can normally be reached on M-F 8:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Jr. Vaughn can be reached on 571-272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Uc

/William C. Vaughn, Jr./
Supervisory Patent Examiner, Art Unit 2144